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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/037,325

01/03/2002

Harry W. Eberle III

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25901

7590

07/09/2010

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EXAMINER

MACARTHUR, VICTOR L

ART UNIT

PAPER NUMBER

3679

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/037,325	<b>Applicant(s)</b> EBERLE, HARRY W.	
	<b>Examiner</b> VICTOR MACARTHUR	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-34 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) 29-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33,34 and 36-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/16/2010</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/17/2009 has been entered.

### ***Election/Restrictions***

Applicant's election with traverse of the Group II decking system, claims 33, 34, 36-38 in the reply filed on 5/3/2010 is acknowledged. The traversal is on the grounds that the Group I anchoring device and Group II decking system have an interdependent relationship, applicants should be allowed a reasonable latitude in claiming their invention, the number of claims is not unduly multiplied, and that the search would be co-extensive, and that the public would be best served to have all inventions in a single application. This is not persuasive as follows:

- Applicant has failed to show why an interdependent relationship renders a restriction requirement improper much less provide any specific evidence proving such relationship. As stated in the restriction requirement mailed 4/1/2010, Group I and II are properly restrictable since the claim 33 decking system does not require the particulars (e.g., "said sides of said top element engaging said receiving slots") of the claim 29 anchoring device; and the claim 33 anchoring device has separate utility such as in a framing construction. Applicant has failed to show otherwise.

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- Applicant has failed to show that the elected invention amounts to an “unreasonable latitude” in claiming their invention, or for that matter, that an otherwise proper restriction would be rendered improper by lack of “latitude”.
- Applicant has failed to show that the number of claims effects the validity of a restriction requirement much less show that applicant’s current number of claims necessitate withdrawal of the restriction requirement.
- Applicant has failed to detail any search, much less show a single search required by both inventions.
- Applicant has failed to show how public interest would be served by withdrawal of a proper restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

Claims 29-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 5/3/2010.

### ***Drawings***

The drawings were received on 12/17/2009. These drawings are not accepted since they contain new matter. Note that the fastener 52 as shown in new figure 9 was not originally presented. For instance, applicant has failed to point out where the fastener’s tapered flush mounted head, tapered shank, specific length, diameter, threading, etc. were originally presented in the application as filed.

The June 8, 2009 drawings remain objected to as detailed below:

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The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, “said anchoring device is anchored by a metal fastener driven therethrough to said support board” (lines 38-40 of claim 33) must be shown or the feature canceled from the claim. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 33, 34 and 36-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform to current U.S. practice as follows:

- It is unclear if claimed “decking system” (line 1 of claim 1) invention is meant to be structurally limited by the “metal fastener” (line 35 and line 39 of claim 33) or if the “metal fastener” is a mere functional intended use for the “decking system”. Note that the “metal fastener” is recited as both intended use “lines 34-35” and as limiting structure “line 39” at the same time. The claim must be amended to consistently refer to the fastener either as functional intended use throughout or as limiting structure throughout. That is to say that it is unclear how the invention can be both intended for use with “a metal fastener” (i.e., by being separate therefrom) and also structurally comprise “a metal fastener” (i.e., not being separate therefrom) at the same time. For purposes of examination the claims are taken without combination.
- The phrase “being measured a” (line 11 of claim 33) is improper and unclear. Does applicant mean to state --being measured at a--?
- It is unclear what element the pronoun “its” (line 19 of claim 33) is meant to refer. The claim must be amended to specify a specific element by name.
- The claims are replete with confusing double inclusions which render the scope unclear. For instance, note the following:

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- It is unclear if “an anchoring device” (line 7 of claim 33) is meant to refer to the previously recited “an anchoring device” (lines 4-5 of claim 33) or to an additional device.
  - It is unclear if “two adjacent boards” (lines 28-29) is meant to refer to the previously recited “plurality of decking boards” (line 2 of claim 33) or to additional boards.
  - It is unclear if “receiving slots” (line 29 of claim 33) is meant to refer to the previously recited “at least one groove” (lines 2-3 of claim 33) or to additional elements. If they are separate elements, how do the grooves differ from the slots?
- The term “said grooves” (line 37 of claim 33) lacks proper antecedent basis. Does applicant mean to state that --said at least one groove comprises a plurality of grooves-- ?
- It is unclear if “each said board” (line 2 of claim 36) is meant to refer to the previously recited decking board, support board, some additional board or some combination thereof.
- It is unclear how applicant's invention has "an upper half of each said board above said groove and a lower half of each said board below said groove" (claim 36). Note that the portions of board (45) that are above and below groove (55) do not make up the entire board such that they cannot each be "half" of the board. Rather, the upper portion, groove portion, and lower portion each appear to make up roughly about a third of the board.

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- It is unclear how claim 38 further limits the invention since the "parallel" limitation is previously presented in claim 33 and thus redundant in claim 38.

For the reasons mentioned above a great deal of confusion and uncertainty exists as to the proper interpretation of the claim limitations. In accordance with the MPEP § 2173.06, rejection under 35 U.S.C. 102 or 35 U.S.C. 103 follows based on the examiner's best understanding of the claim scope. The applicant is strongly urged to carefully review the entirety of the claims and correct any additional clarity issues not noted above such that the claims fully conform to current U.S. practice.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33, 37 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erwin US 2002/0121064 in view of Leash USPN 2115270 and Tremblay USPN 4449346.

Erwin discloses a decking system comprising a plurality of decking boards (10, 12) a support board ("frame member" described in para.0022) each decking board having a groove (22); a molded plastic material anchoring device (24 as described in para.0022 are molded plastic) consisting essentially of a substantially flat horizontal top element (top portion of 24 including 26); a substantially vertical support member (middle portion of 24); and a substantially flat horizontal bottom element (bottom portion of 24). Furthermore:



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- Even though Erwin does not disclose that the bottom portion is trapezoidal in shape, Leash teaches that anchoring devices were extremely well known to use a trapezoidal shaped bottom element (fig.2) rather than a non-trapezoidal shaped bottom element (fig.4). One of ordinary skill in the art (one skilled and knowledgeable enough to design, manufacture, and use decking systems) would know that a trapezoidal shape would act to better support opposite top and bottom sides of the decking boards than a non-trapezoidal shape, which only supports the top side of the decking boards and as such would present a desirable modification. Furthermore, there is no evidence of record that modifying a non-trapezoidal shape to be a trapezoidal shape would have any unexpected results such that the limitation lacks any criticality.
- Even though the Leash trapezoidal shaped bottom element has a width that is equal to (not less than) the Leash top element, Tremblay teaches that anchoring devices were extremely well known to use a trapezoidal shaped bottom element having a width less than the top element. One of ordinary skill in the art (one skilled and knowledgeable enough to design, manufacture, and use decking systems) would know that reducing the width of the bottom element would reduce the amount of material used and thus reduce manufacturing cost thereby being a desirable modification. There is no evidence of record that modifying a bottom element to have a width less than (rather than equal to) a width of a top element would have any unexpected results such that the limitation lacks any criticality.
- MPEP 2144.04 states "**If the applicant has demonstrated the criticality** of a specific limitation, it would not be appropriate to rely solely on case law as the

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rationale to support an obviousness rejection" (emphasis added). However, applicant's disclosure, and all other evidence of record, fails to set forth any unexpected result due to any specific shape or dimension over any other.

Accordingly, the claimed shape and dimension lacks any criticality such that a rejection based on case law is appropriate.

- MPEP 2144 clearly states that "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from **knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law**" (emphasis added).
- MPEP 2144.04(IV)(B) details that changes in shape have been established by case law to be obvious where there is no unexpected result (criticality) citing *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)
- MPEP 2144.04(IV)(A) details that changes in size and/or proportion have been established by case law to be obvious where there is no unexpected result (criticality) citing *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955), *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976), and *In re Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 220 USPQ &&& (Fed. Cir. 1984), *cert. denied*, 469 U.S.830, 225 USPQ 232 (1984).
- It has generally been recognized that the optimization of proportions in a prior art device is a design consideration within the skill of the art. *In re Reese*, 290 F.2d 839, 129 USPQ 402 (CCPA 1961).

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- Note that MPEP 716.01(c)(II) states that “The arguments of counsel cannot take the place of evidence in the record”. Note that MPEP 716.02 states “Evidence must show unexpected results... burden on applicant to establish results are unexpected and significant... applicants have burden of explaining proffered data... expected beneficial results are evidence of obviousness”.
- “[T]he results of **ordinary innovation** are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007) (emphasis added). Accordingly, changing a trivial detail of the prior art (such as bottom element shape or dimension) is at best an “ordinary innovation” if any innovation at all, and therefore does not constitute sufficient reason for patentability.
- Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the bottom element shape to be trapezoidal and to reduce the bottom element width to be less than the top element as taught by Leash and Tremblay, for the benefit of better retaining the decking boards on opposite top and bottom sides, reducing material used and reducing manufacturing cost (knowledge generally available as detailed above), and further since the specific shape and dimension lacks any criticality (lacks any unexpected result as detailed above) and in accordance with the rationale set forth in the MPEP sections and case law noted above.

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Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erwin US 2002/0121064 in view of Leash USPN 2115270 and Tremblay USPN 4449346, as applied to claim 33, and further in view of Curtis, Jr. 4,154,172.

Regarding claim 34, Erwin, as modified, fails to disclose the vertical support member having recesses with support columns located therebetween. Curtis, Jr. teaches in Figure 2 and 4, a support column 17', 21 having recesses (the openings) to allow the insertion of a fastener therethrough (col. 2, lines 30-33, and col. 2, line 68, to column 3, line 4) and connect the anchoring device to anchoring boards. Therefore, as taught by Curtis, Jr., it would have been obvious to one of ordinary skill in the art at the time the invention was made to include recesses on the vertical support member to allow the insertion of a fastener thus connecting the anchoring device to the anchoring boards of Erwin. Given the modification, support columns would have been located between the recesses in general.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erwin US 2002/0121064 in view of Leash USPN 2115270 and Tremblay USPN 4449346, as applied to claim 33, and further in view of Ring USPN 239846.

Ring teaches that the upper portion of a decking a board should have a greater width than the lower portion. One of ordinary skill would have seen the resulting reduction in space between boards as beneficial for reducing the likelihood of trapping dirt and debris as well as presenting a lower tripping hazard. Therefore it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the dimensions of the Erwin board such that the upper portion has a greater width than the lower portion for the purpose of reducing

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the upper surface space between boards thereby reducing the likelihood of trapping dirt and debris as well as reducing the tripping hazard.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

July 12, 2010

/Victor MacArthur/  
Primary Examiner, Art Unit 3679